



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/784,591

02/23/2004

Charles Black

YOR920010225US2

9561

47939 7590 02/15/2008
CONNOLLY BOVE LODGE & HUTZ LLP
(FOR IBM YORKTOWN)
P.O. BOX 2207
WILMINGTON, DE 19899-2207

EXAMINER

GOODWIN, DAVID J

ART UNIT

PAPER NUMBER

2818

MAIL DATE

DELIVERY MODE

02/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,591	Applicant(s) BLACK ET AL.	
	Examiner DAVID GOODWIN	Art Unit 2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,24,35,37,50,51 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,24,35,37,50,51 and 53-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 20 states that "said nanoparticles in a range of about 50% to about 100%." Claim 20 does not specify what property of the nanoparticles or film falls within this percentage range.

4. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 35 states that "a percentage of the film comprising nanoparticles is in a range of about 25% to about 75%."

6. It is unclear whether the applicant intended this range to narrow the described range of claim 20. In which case claim 35 fails to further limit claim 20. 37 CFR 1.75(c) MPEP 608.01(n).

7. Claim 35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 35 recites the limitations “a percentage of said thin film comprising said nanoparticles is in a range of about 25% to about 75%.” However, the applicant uses “consisting of language” which would exclude the inclusion of any element not specified in the claim. The claim is therefore unclear as the layer claim requires the unspecified at least 25% to be excluded.

9. Claim 50 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 50 recites the limitations “a percentage of said thin film comprising said nanoparticles is in a range of about 50% to about 60%.” However, the applicant uses “consisting of language” which would exclude the inclusion of any element not specified in the claim. The claim is therefore unclear as the layer claim requires the unspecified at least 40% to be excluded.

11. Claim 51 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 51 recites the limitations “a percentage of said thin film comprising said nanoparticles is in a range of about 90% to about 100%.” However, the applicant uses “consisting of language” which would exclude the inclusion of any element not specified in the claim. The claim is therefore unclear as the layer claim requires the unspecified up to 10% to be excluded.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 24, 37, 53, 54, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Chivukula (US 6,066,581).

2. Regarding claim 37.

3. Chivukula teaches a dielectric layer. Said layer is lead zirconate titanate and has a dielectric constant greater than 10 (column 13 lines 15-25). Said layer comprises particles having a diameter between 10 and 15 nm and a uniform size (column 15 lines 1-10). Particles having a uniform size would have a standard deviation of 0%.

4. Note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

a. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

5. Regarding claim 24.

6. Chivukula teaches that the particles of the layer are composed of perovskite ABO₃ material lead zirconium titanate (column 14 lines 20-55).

7. Regarding claim 53.

8. As the surfactant is removed from the layer, said material does not form part of the layer.

9. Note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

b. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d

1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

10. Regarding claim 54.

11. As the surfactant is removed from the layer, said material does not form part of the layer.

12. Note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

c. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*. 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

13. Regarding claim 55.

Art Unit: 2818

14. As the solvent is removed from the layer, said material does not form part of the layer.

15. Note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

d. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

16.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.

Art Unit: 2818

3. Claims 20, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chivukula (US 6,066,581).
4. Regarding claim 20.
5. Chivukula teaches that the layer is composed of nanoparticles (column 15 lines 1-10).
6. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

7.

8. Regarding claim 50.
9. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are

Art Unit: 2818

critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

10. Regarding claim 51.

11. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

Art Unit: 2818

The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

12.

13. Claims 20, 24, 35, 37, 50, 51, 53, 54, and 55 are rejected under 35 U.S.C.

103(a) as being unpatentable over Leung (US 2002/0137260) in view of Matijev (US 5,900,223).

14. Regarding claim 37

15. Leung teaches a dielectric layer. Said dielectric layer consists of nanoparticles have a 2nm diameter and having a monodisperse size distribution, which is less than 5% standard deviation (paragraph 0021). The nanoparticles may be coated with a surfactant (paragraph 0021).

16. Leung does not teach the dielectric constant of the material.

17. Matijevic teaches barium titanate nanoparticles (column 12 lines 30-45). Barium titanate has a dielectric constant higher than 10.

18. It would have been obvious to one of ordinary skill in the art to use barium titanate nanoparticles in order to make advanced superior products which have nanoparticles having good sinterability, dense packing, fine grained structure, and a high dielectric constant.

19. Note that a "product by process" claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related

Art Unit: 2818

case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

- a. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

20.

21. Regarding claim 50.

22. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation”. *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

23. Regarding claim 51.

24. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

25. Regarding claim 20.

26. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. "Where the general conditions of a claim are disclosed in the prior art, it is not

inventive to discover the workable ranges by routine experimentation”. *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

27. Regarding claim 35

28. Differences in density will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such density are critical. “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation”. *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Since the applicant has not established the criticality (see next paragraph) of the density, and this density has been used in similar devices in the art (see, e.g., Matijavic column 7 lines 40-50) it would have been obvious to one of ordinary skill in the art to use these values in the device.

CRITICALITY

29. The specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

30. Regarding claim 53.

31. Leung teaches that the surfactant is not added (paragraph 0021).

32. Regarding claim 54.

1. In an embodiment where the functional groups are removed from the surface of the nanoparticle note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

a. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*. 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

33. Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

34. Regarding claim 55.

35. Leung teaches that the solvent is removed (paragraph 0023).

2. Note that a “product by process” claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related

Art Unit: 2818

case law cited therein which make it clear that it is the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. As stated in *Thorpe*,

b. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*. 411 F2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

36. Regarding claim 24

37. Matijev teaches that barium titanate.

38. It would have been obvious to one of ordinary skill in the art to use barium titanate nanoparticles in order to make advanced superior products which have nanoparticles having good sinterability, dense packing, fine grained structure, and a high dielectric constant.

39. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leung (US 2002/0137260) in view of Matijev (US 5,900,223) as applied to claim 37 and further in view of Yokouchi (US 5,143,637).

40. Regarding claim 54

41. Leung in view of Matijev teaches elements of the claimed invention above.

42. Leung in view of Matijev does not teach the composition of the surfactant.
43. Yokouchi teaches a particle surfactant comprising a carboxyl group (column 5 lines 25-35).
44. It would have been obvious to one of ordinary skill in the art to coat the particles with carbyl groups in order to increase the dispersion of the particles.
- 17.

Response to Arguments

18. Applicant's arguments filed 12/10/07 have been fully considered but they are not persuasive.
19. The applicant argues that the prior art does not teach that the nanoparticles are coated with surfactant.
20. The applicant notes that the Leung solution comprises surfactant and that the Leung nanoparticles are in the solution. A nanoparticle that is in a solution will be coated with said solution, and if that solution contains surfactant then the nanoparticles are coated with a solution comprising surfactant.
21. Further, note that a "product by process" claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and related case law cited therein which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in *Thorpe*,

e. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147, (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir 1935).

Note that Applicant bears the burden of proof in such cases as the above case law makes clear.

22. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2818

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID GOODWIN whose telephone number is (571)272-8451. The examiner can normally be reached on Monday through Friday, 9:00am through 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Loke can be reached on (571)272-1657. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven Loke/

Supervisory Patent Examiner, Art Unit 2818

Application/Control Number: 10/784,591
Art Unit: 2818

Page 19

DJG